

REMARKS

In the November 29, 2000 Office Action, claims 1-87 and 118-132 stand rejected in view of prior art, claims 88-102 stand rejected as being indefinite, and claims 88-117 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting. Finally, the title of the invention was objected to for not being descriptive.

Status of Claims (Amendments)

In response, Applicants have amended claims 1, 16, 31, 46, 60, 74, 88 and 118. Also, Applicant has amended the title to be clearly indicative of the invention to which the claims are directed. Additionally, a Terminal Disclaimer is being filed herewith. Reexamination and reconsideration of the pending claims are respectfully requested in view of the Terminal Disclaimer (filed herewith), the foregoing amendments and the following comments.

Attached hereto is a marked-up version of the changes made to the claims and the specification. The attached pages are captioned MARKED-UP VERSION OF AMENDMENTS (pages 11-14).

Title of Invention

In paragraph 1 of the Office Action, the title of the invention is objected to for not being descriptive, and a new title is required that is clearly indicative of the invention to which the claims are directed. In response, Applicants have amended the title to be clearly indicative of the invention to which the claims are directed. Specifically, the title, as amended is BRACKET ASSEMBLY, ESPECIALLY FOR USE AS A MAGNETIC DEVICE IN A MONITORING DEVICE. Accordingly, withdrawal of this objection is respectfully requested.

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Drawings

In paragraph 2 of the Office Action, the Office Action indicates that this application has been filed with informal drawings, which are acceptable for examination purposes only. The Office Action further indicates that formal drawings will be required when the application is allowed. Applicants acknowledge the requirement for formal drawings upon allowance of this application.

Claim Rejections - 35 USC § 112

In paragraph 3 of the Office Action, claims 88-102 stand rejected under 35 USC § 112, 2nd paragraph as being indefinite. Specifically, the Office Action indicates that "said concavity" in claim 88 lacks antecedent basis. In response, Applicants have amended independent claim 88 to provide proper antecedent basis for "said concavity". Additionally, Applicants corrected a similar error in independent claim 118. Accordingly, withdrawal of this rejection is respectfully requested.

Claim Rejections – Double Patenting

In paragraphs 4 and 5 of the Office Action, claims 88-117 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of co-pending Application No. 09/255,345. The Office Action also indicates that although the conflicting claims are not identical, they are not patentably distinct from each other because claims 88-117 are broader than and encompass the boundaries of claims 1-18. Furthermore, the Office Action indicates that a timely filed Terminal Disclaimer in compliance with 37 CFR 1.321 may be used to overcome an actual of provisional rejection based on non-statutory double patenting.

In response, Applicants have filed herewith a Terminal Disclaimer to overcome this rejection. Accordingly, withdrawal of this rejection is respectfully requested. Applicants

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note that Application Serial No. 09/255,345 issued as U.S. Patent No. 6,188,215 on February 13, 2001. In other words, this patent issued after the mailing date of the Office Action. The issuance of this patent is reflected in the Terminal Disclaimer.

Claim Rejections - 35 USC § 103 (a)

In paragraphs 6-8 of the Office Action, claims 1-87 and 118-132 stand rejected under 35 USC § 103 (a) as being unpatentable over a variety of references. Specifically, claims 1, 3, 4, 10, 12-15, 46 and 48-59 stand rejected under 35 USC § 103 (a) as being unpatentable over U.S. Patent No. 3,781,082 to Linder ("the Linder patent") in view of U.S. Patent No. 5,452,945 to Schlanger ("the Schlanger patent"). Additionally, claims 2,5-9,11,16-45,47, 60-87 and 118-132 stand rejected under 35 USC § 103 (a) as being unpatentable over U.S. Patent No. 5,089,775 to Takeda ("the Takeda patent") in view of the Linder patent and the Schlanger patent. In response, Applicants have amended claims 1, 16, 31, 46, 60, 74 and 118 to overcome these rejections.

Specifically, independent claims 1 and 46, as now amended, require *a bracket assembly configured to mount on a single spoke with at least one flat portion*. Additionally, independent claims 16 and 60, as now amended, *require a magnetic device with a housing configured to mount on a single spoke with at least one flat portion*, while independent claims 31 and 74, as now amended, require *a monitoring device with a magnetic device configured to be mounted on a single spoke with at least one flat portion*. Applicants do not believe the unique arrangement of independent claims 1, 16, 31, 46, 60 and 74 is disclosed or suggested in the references cited in the Office Action.

Regarding independent claim 118, this claim has now been amended to include limitations similar to independent claims 88 and 103 (not rejected in view of prior art).

Accordingly, Applicants do not believe the unique arrangement of independent claim 118 is disclosed or suggested in the prior art.

Specifically, the Linder patent basically discloses a reflector holder designed to be mounted on a pair of round spokes. The Schlanger patent basically discloses a bicycle wheel with flat spokes. The Schlanger patent fails to disclose a bracket assembly or holder whatsoever. The Takeda patent basically discloses a magnet designed to be mounted on a round spoke via screw. The Office Action indicates that it would have been obvious to use the reflector holder of the Linder patent with the flat spokes of the Schlanger patent. The Office Action further indicates that it would have been obvious to combine the magnet of the Takeda patent with the reflector of the Linder patent and mount this hypothetical device on the wheel of the Schlanger patent. Applicants respectfully disagree with the position of the Office Action.

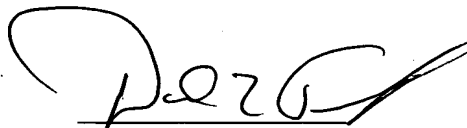
It is well settled in U.S. patent law that the mere fact that the prior art can be modified does *not* make the modification obvious, unless the prior art *suggests* the desirability of the modification. *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989). In fact, both the *suggestion* and the *expectation* of success must be found in the prior art, *not* in Applicants' disclosure. *In re O'Farrell*, 853 F.2d 894, 7 USPQ2d 1673 (Fed. Cir. 1988). Accordingly, the prior art of record lacks any suggestion or expectation of success for combining the patents to create the Applicants' unique arrangement of the independent claims. In any event, Applicants have amended independent claims 1, 16, 31, 46, 60, 74 and 118 to more clearly distinguish the prior art. Accordingly, withdrawal of these rejections is respectfully requested.

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In view of the Terminal Disclaimer (filed herewith) and the foregoing amendments and comments, Applicants believe claims 1-132 are now allowable over the prior art of record. Reexamination and reconsideration of these pending claims are respectfully requested. If there are any questions regarding this amendment, please feel free to contact the undersigned.

Respectfully submitted,



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DLT/PAH/sjm

c:\Mar\F0422SN-US Amendment

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MARKED-UP VERSION OF AMENDMENTS

Claim 1 has been amend as follows:

1. (Amended) A bracket assembly for mounting on a single spoke having at least one flat portion, comprising:

a housing having a flat spoke-receiving recess with non-circular cross section and at least one detent extending from said housing into said flat spoke-receiving recess to non-rotatably secure the at least one flat portion of the single spoke within said spoke-receiving recess via a snap-fit.

Claim 16 has been amend as follows:

16. (Amended) A magnetic device for mounting on a single spoke having at least one flat portion, comprising:

a housing having a spoke-receiving recess with non-circular cross section and at least one detent extending from said housing into said spoke-receiving recess to non-rotatably secure the at least one [a] flat portion of the single spoke within said spoke-receiving recess via a snap-fit; and

a magnetic material fixedly coupled to said housing.

Claim 31 has been amend as follows:

31. (Amended) A monitoring device for a bicycle, comprising:

a sensing device; adapted to be coupled to a portion of the bicycle that is adjacent a wheel of the bicycle;

a display unit adapted to be mounted on handlebars of the bicycle; and

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a magnetic device adapted to be mounted on a single spoke of a spoked wheel, the single spoke having a flat portion, said magnetic device including a housing and magnetic material fixedly coupled to said housing,

said housing having a spoke-receiving recess with non-circular cross section and at least one detent extending from said housing into said spoke-receiving recess to non-rotatably secure the at least one [a] flat portion of the single spoke within said spoke-receiving recess via a snap-fit.

Claim 46 has been amend as follows:

46. (Amended) A [monitoring device] bracket assembly for mounting on a single spoke having at least one flat portion, comprising:

a housing having a spoke-receiving recess with a pair of opposed side walls spaced apart by a first predetermined distance and defining a non-circular cross section to non-rotatably receive the at least one flat portion of the single spoke therebetween, said side walls being constructed of an elastic material to elastically retain the at least one flat portion of the single spoke therebetween, said first predetermined distance being slightly smaller than a predetermined width of the at least one flat portion of the single spoke to elastically deform said side walls.

Claim 60 has been amend as follows:

60. (Amended) A magnetic device for mounting on a single spoke having at least one flat portion, comprising:

a housing having a spoke-receiving recess with a pair of opposed side walls spaced apart by a first predetermined distance and defining a non-circular cross section to non-

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rotatably receive the at least one flat portion of the single spoke therebetween, said side walls being constructed of an elastic material to elastically retain the at least one flat portion of the single spoke therebetween, said first predetermined distance being slightly smaller than a predetermined width of the at least one flat portion of the single spoke to elastically deform said side walls; and

a magnetic material fixedly coupled to said housing.

Claim 74 has been amend as follows:

74. (Amended) A monitoring device for a bicycle, comprising:

a sensing device; adapted to be coupled to a portion of the bicycle that is adjacent a wheel of the bicycle;

a display unit adapted to be mounted on handlebars of the bicycle; and

a magnetic device adapted to be mounted on a single spoke of a spoked wheel [spokes], the single spoke having [a] at least one flat portion, said magnetic device including a housing and magnetic material fixedly coupled to said housing,

said housing having a spoke-receiving recess with a pair of opposed side walls spaced apart by a first predetermined distance and defining a non-circular cross section to non-rotatably receive the at least one flat portion of the single spoke therebetween, said side walls being constructed of an elastic material to elastically retain the at least one flat portion of the single spoke therebetween, said first predetermined distance being slightly smaller than a predetermined width of the at least one flat portion of the single spoke to elastically deform said side walls.

Claim 88 has been amend as follows:

88. (Amended) A bracket assembly for mounting on a spoke [having at least one flat portion] with a concavity, comprising:

a housing having a spoke-receiving recess with a pair of opposed side walls spaced apart by a first predetermined distance to retain the spoke therebetween, and a projection extending from said spoke-receiving recess to engage the concavity of the spoke within said spoke-receiving recess.

Claim 118 has been amend as follows:

118. (Amended) A monitoring device for a bicycle, comprising:

a sensing device; adapted to be coupled to a portion of the bicycle that is adjacent a wheel of the bicycle;

a display unit adapted to be mounted on handlebars of the bicycle; and

a magnetic device adapted to be mounted on a spoke with a concavity of a spoked wheel [spokes having a flat portion], said magnetic device including a housing and magnetic material fixedly coupled to said housing,

said housing having a spoke-receiving recess with a pair of opposed side walls spaced apart by a first predetermined distance to retain the spoke therebetween, and a projection extending from said spoke-receiving recess to engage the concavity of the spoke within said spoke-receiving recess.

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